UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,698	02/02/2000	ANDREW D. Simchik	XXT-036CP	6586

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EXAMINER
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ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	09/496,698	SIMCHIK ET AL.
	Examiner	Art Unit
	Joseph R. Pokrzywa	2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>02 February 2000</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Priority

1.   Acknowledgment is made of a claim for domestic priority under 35 U.S.C. 120.

Information Disclosure Statement

2.   The references listed in the Information Disclosure Statement submitted on 11/13/02 have been considered by the examiner (see attached PTO-1449).

Drawings

3.   The drawings are objected to because of the problems addressed in the attached PTO-948. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   **Claims 1-6, and 23** are rejected under 35 U.S.C. 102(e) as being anticipated by Crosby *et*

al. (U.S. Patent Number 6,507,848).

Regarding *claim 1*, Crosby discloses in a printing system (see abstract, Fig. 1, column 1,

lines 8 through 47, and column 4, lines 25 through 27), a method for converting a page from a

network into an image file suitable for assembly into a document generated by a document

creation algorithm (column 1, line 30 through column 2, line 3, column 3, line 52 through

column 4, line 61, and column 6, lines 20 through 36), the method comprising the steps of

translating (via the output container application 104) a page from the network into a page

description language (PDL) file representative of the page (column 3, line 64 through column 4,

line 24, and column10, lines 38 through column 11, line 19), and translating (via the distiller

106) the PDL file into an image file representative of the page suitable for assembly into the

document (column 4, lines 46 through 67, and column 11, line 41 through column 12, line 12).

Regarding *claim 2*, Crosby discloses the method discussed above in claim 1, and further

teaches of the steps of launching a web browser, and retrieving a web page from the network

(column 9, lines 2 through 15).

Regarding *claim 3*, Crosby discloses the method discussed above in claim 1, and further

teaches of the step of importing the image file into the document (column 1, lines 15 through 29,

column 2, line 55 through column 3, line 15, and column 3, line 64 through column 4, line 24).

Regarding *claim 4*, Crosby discloses the method discussed above in claim 1, and further

teaches of the step of integrating the image file into the document (column 1, lines 15 through

29, column 2, line 55 through column 3, line 15, and column 3, line 64 through column 4, line

24).

Regarding *claim 5*, Crosby discloses the method discussed above in claim 1, and further

teaches of the steps of converting the image file into a page, and importing the page into the

document generated by the document creation algorithm (column 1, lines 15 through 29, column

2, line 55 through column 3, line 15, and column 3, line 64 through column 4, line 24).

Regarding *claim 6*, Crosby discloses the method discussed above in claim 1, and further

teaches of the step of printing the image file with a printing module (column 4, lines 25 through

45, and column 11, lines 10 through 63).

Regarding *claim 23*, Crosby discloses a computer-readable medium holding computer-

executable instructions (see Figs. 1 and 2, and column 1, lines 15 through 29) for converting a

page from a network into an image file suitable for subsequent assembly into a document

generated by a document creation algorithm (column 1, line 30 through column 2, line 3, column

3, line 52 through column 4, line 61, and column 6, lines 20 through 36), comprising translating

(via the output container application 104) the page into a page description language (PDL) file

representative of the page (column 3, line 64 through column 4, line 24, and column10, lines 38

through column 11, line 19), and translating (via the distiller 106) the PDL file into an image file

representative of the page and suitable for assembly into the document generated by the

document creation algorithm (column 4, lines 46 through 67, and column 11, line 41 through

column 12, line 12).

6.   **Claims 8-22, and 24** are rejected under 35 U.S.C. 102(e) as being anticipated by Bobrow

et al. (U.S. Patent Number 6,529,285).

Regarding *claim 8*, Bobrow discloses a method suitable for use with a printing system

(see Figs. 4 and 7) for dynamically linking content present in a page in a network with a

document (see Figs. 10, 15, and 24, and column 29, line 42 through column 30, line 16), the

method comprising the steps of inserting a link into the document (column 18, lines 5 through

58, and column 29, line 42 through column 30, line 16), the link corresponding to a page present

in the network (column 18, lines 44 through 58, and seen in Fig. 24, step BB), launching a

browser in response to the link (steps CC and DD, column 29, lines 50 through 62), retrieving

the page from the network (step DD, column 29, lines 55 through 62), and converting the page

into an image file suitable for insertion into the document (see Figs. 15 and 24, step EE, column

29, lines 58 through 66).

Regarding *claim 9*, Bobrow discloses the method discussed above in claim 8, and further

teaches that the step of inserting a link comprises the step of inserting a uniform resource locator

(URL) into the document (column 18, lines 5 through 58, and column 29, line 42 through

column 30, line 10), and wherein the step of launching comprises the step of launching a web

browser (see Figs. 15 and 24, step EE, column 29, lines 58 through 66), wherein the URL

corresponds to a web page in the network (column 18, lines 44 through 58, and seen in Fig. 24, step BB).

Regarding *claim 10*, Bobrow discloses the method discussed above in claim 8, and further teaches that the step of converting comprises the step directly inserting the image file into the document (see Figs. 15 and 24, step EE, column 19, line 51 through column 20, line 9, and column 29, lines 58 through 66).

Regarding *claim 11*, Bobrow discloses the method discussed above in claim 8, and further teaches that the page includes a web page and the browser includes a web browser (see Figs. 15 and 24, step EE, column 29, lines 58 through 66), further comprising the step of automatically, dynamically inserting the link into the document to dynamically retrieve content associated with the web page for subsequent incorporation into the document (column 18, lines 5 through 58, and column 29, line 42 through column 30, line 10).

Regarding *claim 12*, Bobrow discloses the method discussed above in claim 8, and further teaches of the step of repeating the steps of inserting, launching, retrieving, and converting as a function of the number of links inserted into the document (see Figs. 15 and 24, being repetitive process loops).

Regarding *claim 13*, Bobrow discloses a printing system (see Figs. 4 and 7) for converting a page from a network into image data suitable for subsequent assembly into a document generated by a document creation algorithm (see Figs. 10, 15, and 24, and column 29, line 42 through column 30, line 16),

the system comprising a browser for accessing the network and for retrieving a page therefrom (steps CC and DD, column 29, lines 50 through 62), and

a production facility for translating the page into an image file representative of the page

and suitable for assembly into the document generated by the document creation algorithm (see

Figs. 15 and 24, step EE, column 19, line 51 through column 20, line 9, and column 29, lines 58

through 66).

Regarding *claim 14*, Bobrow discloses the system discussed above in claim 13, and

further teaches that the production facility comprises a first translator for translating the page into

a page description language (PDL) file representative of the page (column 14, lines 20 through

28), and a second translator for translating the PDL file into an image file representative of the

page (column 10, lines 1 through 67).

Regarding *claim 15*, Bobrow discloses the system discussed above in claim 13, and

further teaches that the page includes a web page (column 18, lines 44 through 58, and seen in

Fig. 24, step BB), and that the production facility comprises a link facility for inserting a uniform

resource locator (URL) into a document created by the document creation algorithm (column 18,

lines 44 through 58, and column 29, line 42 through column 30, line 10), the URL corresponding

to the web page (column 18, lines 44 through 58, and seen in Fig. 24, step BB).

Regarding *claim 16*, Bobrow discloses the system discussed above in claim 13, and

further teaches of means for importing the image file into the document (column 18, line 44

through column 19, line 3, and column 19, line 51 through column 20, line 9).

Regarding *claim 17*, Bobrow discloses the system discussed above in claim 13, and

further teaches of a printing module for printing the document (see Fig. 10, printers 212 and 220,

column 15, lines 7 through 57).

Regarding *claim 18*, Bobrow discloses the system discussed above in claim 13, and further teaches that the page includes a web page (column 18, lines 44 through 58, and seen in Fig. 24, step BB), further comprising a link facility for inserting a uniform resource locator (URL) into a document created by the document creation algorithm (column 18, lines 44 through 58, and column 29, line 42 through column 30, line 10), the URL corresponding to the web page (column 18, lines 44 through 58, and seen in Fig. 24, step BB).

Regarding *claim 19*, Bobrow discloses the system discussed above in claim 17, and further teaches of means for dynamically inserting the image file into the document (column 18, line 44 through column 19, line 3, and column 19, line 51 through column 20, line 9).

Regarding *claim 20*, Bobrow discloses a printing system (see Figs. 4 and 7) for dynamically linking content present in a page in a network with a document generated by a document creation algorithm (see Figs. 10, 15, and 24, and column 29, line 42 through column 30, line 16), the system comprising a link facility for inserting a link into the document (column 18, lines 44 through 58, and column 29, line 42 through column 30, line 10), the link corresponding to a page having content (column 18, lines 44 through 58, and seen in Fig. 24, step BB), a browser for retrieving the page from the network, and a production facility for translating the page into an image file suitable for insertion within the document (steps CC and DD, column 29, lines 50 through 62).

Regarding *claim 21*, Bobrow discloses the system discussed above in claim 20, and further teaches that the link facility comprises means for inserting a uniform resource locator (URL) into the document (column 18, lines 44 through 58, and column 29, line 42 through

column 30, line 10), wherein the URL corresponds to the page in the network (column 18, lines 44 through 58, and seen in Fig. 24, step BB).

Regarding *claim 22*, Bobrow discloses the system discussed above in claim 20, and further teaches that the page includes a web page, and the browser includes a web browser (see Fig. 24, and column 29, lines 42 through 62), further comprising means for inserting the link into the document to dynamically and automatically retrieve content associated with the web page (column 18, lines 44 through 58, and column 29, line 42 through column 30, line 10).

Regarding *claim 24*, Bobrow discloses a computer-readable medium holding computer-executable instructions (see Fig. 9) for dynamically linking content present in a page in a network with a document (see Figs. 10, 15, and 24, and column 29, line 42 through column 30, line 16), comprising inserting a link into the document (column 18, lines 44 through 58, and column 29, line 42 through column 30, line 10), the link corresponding to a page having content present in the network (column 18, lines 44 through 58, and seen in Fig. 24, step BB), and converting the page into an image file suitable for insertion within the document (column 19, line 51 through column 20, line 9, and column 29, line 50 through column 30, line 10).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

8.   **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Crosby *et al.* (U.S.

Patent Number 6,507,848) in view of Bobrow *et al.* (U.S. Patent Number 6,529,285).

Regarding *claim 7*, Crosby discloses the method discussed above in claim 1, but fails to

particularly teach the steps of inserting a uniform resource locator (URL) into the document

created by the document creation algorithm, the URL corresponding to the web page, and

dynamically inserting the image file corresponding to the web page into the document. Bobrow

discloses in a printing system (see abstract and Fig. 4), a method for converting a page from a

network into an image file suitable for assembly into a document generated by a document

creation algorithm (see Fig. 4), the method comprising the steps of receiving a page from the

network in a page description language (PDL) file representative of the page (column 14, lines

20 through 28), and translating the PDL file into an image file representative of the page suitable

for assembly into the document (column 10, lines 1 through 67). Further, Bobrow teaches of the

steps of inserting a uniform resource locator (URL) into the document created by the document

creation algorithm (column 18, lines 44 through 58, and column 29, line 42 through column 30,

line 10), the URL corresponding to the web page (column 18, lines 44 through 58, and seen in

Fig. 24, step BB), and dynamically inserting the image file corresponding to the web page into

the document (see Figs. 15 and 24, step EE, column 29, lines 58 through 66). Therefore, it would

have been obvious to a person of ordinary skill in the art at the time the invention was made to

incorporate the teachings of Bobrow in the system of Crosby. Crosby's system would easily be

modified to include the teachings of Bobrow, as the systems share cumulative features, being

additive in nature.

Citation of Pertinent Prior Art

9.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure:

Adamske *et al.* (U.S. Patent Number 6,615,234) discloses a system that converts an

electronic document into a PostScript file, which is further processed to create preview images;

Robertson *et al.* (U.S. Patent Number 6,507,410) discloses a system that creates printed

documents that include hyperlinks to web pages; and

Mayle *et al.* (U.S. Patent Number 6,018,774) discloses a system that generates a page

description file, which is then converted into a gray scale image.

Conclusion

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson. MUST be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings MUST be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes

Timing of Corrections

Applicant is required to submit the drawing corrections <u>within the time period set in the attached Office communication</u>. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in ABANDONMENT of the application

06/01/01